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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|------------------|
| 10/540,805 | 06/27/2005 | Gunter Tewes | VO-729 | 9273 |
| 43419 7590 04/16/2008 PAULEY PETERSEN & ERICKSON 2800 WEST HIGGINS ROAD SUITE 365 HOFFMAN ESTATES, IL 60195 | | | | |
| EXAMINER | | | | |
| SINGH, SUNIL | | | | |
| ART UNIT | | PAPER NUMBER | | |
| 3672 | | | | |
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/540,805

Applicant(s)

TEWES ET AL.

Examiner

Sunil Singh

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 January 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SG/US)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-7, 8-10, 11-15, 16, 17-18,19 are rejected under 35 U.S.C. 102(b) as being anticipated by WO '238.

WO '238 discloses a cutting tool of a cutting machine having a base element (12) and a chisel holder (3) , wherein the base element has a plug-in receptacle (11) spatially connected with its surroundings via an opening, and the chisel holder has a plug-in shoulder disposed through the opening and retained in the plug-in receptacle of the base element, the cutting tool comprising: the chisel holder (3) having a stop (see Fig. 1, close to where member 14 is pointing) resting against a second stop (see Fig. 1 close to where member 14 is pointing) of the base element (12), the base element (12) having a shoulder (see Fig. 1 close to where member 4,18,22 is pointing) extending at an angle relative to the second stop, a clearance (see Fig. 1 close to where member 18 is pointing) forming an adjusting space between the shoulder of the base element (12) and a side of the chisel holder (3) facing the shoulder, and a sealing element (18) closing the opening, the sealing element (18) including a portion having a shape that bridges the clearance.

With regards to claims 8-10, 16, the wedge shape is shown in Figure 5C.

It should be noted that the bezel surface is considered as the lower part of member (14) and the shoulder is considered to include the upper part of member (14) as well surfaces close to where members 4,18,22 are pointing as well.

3. Claims 1-7, 8-10, 11-15, 16, 17-18,19 are rejected under 35 U.S.C. 102(b) as being anticipated by Wrulich et al. (US 4456306).

Wrulich et al. discloses a cutting tool of a cutting machine having a base element (1) and a chisel holder (3) , wherein the base element has a plug-in receptacle (see Figure) spatially connected with its surroundings via an opening, and the chisel holder has a plug-in shoulder disposed through the opening and retained in the plug-in receptacle of the base element, the cutting tool comprising: the chisel holder (3) having a stop (see Fig. 1, close to where reference character 32 is) resting against a second stop (see Fig. 1 close to where reference character 32 is) of the base element (1), the base element (1) having a shoulder (see Fig. 1 close to where member 5 is pointing) extending at an angle relative to the second stop, a clearance (see Fig. 1 close to where member 5 is pointing) forming an adjusting space between the shoulder of the base element (1) and a side of the chisel holder (3) facing the shoulder, and a sealing element (5) closing the opening, the sealing element (5) including a portion having a shape that bridges the clearance.

With regards to claims 8-10, 16, the wedge shape is shown in the Figure

It should be noted that the bezel surface is considered to be the surface area close to where member 5 is pointing.

It should be noted that the shoulder is considered to be the surface area close to where member 5 is pointing.

Response to Arguments

4. Applicant's arguments filed 1/8/08 have been fully considered but they are not persuasive. Applicant argues that examiner identifies the "clearance" as member (16) and the sealing member (18) does not bridge the clearance member (16). It is clear from anyone viewing this case that the "clearance" should have been identified as the opening where reference character 18 is pointing and the sealing element 18 bridges such clearance. However, due to a typographical error, "clearance" which should have been identified as opening close to where member 18 is pointing was indicated as member 16.

Conclusion

5. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sunil Singh whose telephone number is (571) 272-7051. The examiner can normally be reached on Monday through Friday 10:30 AM - 7:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Bagnell can be reached on (571) 272-6999. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Sunil Singh/
Primary Examiner, Art Unit 3672

Sunil Singh
Primary Examiner
Art Unit 3672

SS

4/8/08